

REMARKS

In an Advisory Action dated October 2, 2008, the Examiner maintains the rejections set forth in the final Office Action of July 16, 2008. Claims 1-7 and 28 are thus pending and stand rejected. Applicants respectfully request reconsideration and allowance of the present application in view of the following amendments and remarks.

Amendments to the Claims

Independent claim 1 is amended to recite that the sheath includes a distal end having a cutting edge for harvesting a bone plug from bone tissue. Support for this amendment can be found in paragraphs [0039]-[0041] of the application. No new matter is added.

Rejections Pursuant to 35 U.S.C. §103**Simon in view of Hallac**

Claims 1 and 3-5 are rejected pursuant to 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,346,497 of Simon in view of U.S. Patent No. 3,605,721 of Hallac. Applicants respectfully disagree.

Claim 1, as amended, requires an apparatus for harvesting bone plugs having a tube with an inner bore and a sheath disposed around the tube and including a distal end having a cutting edge for harvesting a bone plug from bone tissue and a tooth extending towards the inner bore for cutting bone to extract a bone plug. Simon teaches surgical cutting heads that have an inner tube with a cutting portion formed on a distal end thereof and an exterior guard tube disposed around the inner tube. The exterior guard tube does not have any sort of cutting edge on a distal end thereof. To the contrary, the exterior guard tube is specifically configured to act as a shield that prevents tissue from being accidentally cut by the inner tube. Simon also fails to teach or suggest a tooth for cutting bone on the guard tube, as explained in Applicants' previous response. While the Examiner asserts that the guards (17) are capable of cutting bone, Applicants continue to disagree. It is *impossible* for the guards (17) to cut bone because they are specifically designed to do just the opposite, namely, to protect tissue from being cut.

Accordingly, Simon lacks an outer tube having both a cutting edge and a tooth on the distal end and thus fails to meet the requirements of claim 1.

Hallac does not remedy the deficiencies of Simon as Hallac simply teaches collapsible biopsy needles. The needles do not have any cutting edges on a distal end or a cutting tooth. Accordingly, Simon and Hallac do not teach the claimed method.

Applicants further note that it would not have been obvious to modify the exterior guard tube of Simon with a cutting edge because the exterior guard tube is required to guard against the cutting of tissue. Simon teaches that “[t]he proximal ends 4 and 13 of the exterior and interior tubes 2 and 3, respectively, can be coterminous, or the proximal end 4 of the inner tube 3 can be slightly recessed within the exterior tube 2....to prevent the sharp points of the cutting edges 10 and 12...from catching and rotating during surgery.” *Simon, col. 5, line 61 – col. 6, line 4*. Simon goes on to teach that guards (17) can be included on the end of the exterior tube to extend over the entire cutting edge of the interior tube to give even further protection against the unwanted cutting of tissue. MPEP 2143.01 requires that a “proposed modification not render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference.” If the exterior guard tube of Simon were modified with a cutting edge, it would render the exterior tube of Simon unsatisfactory for its intended purpose, namely, to guard against cutting. Thus, no person of ordinary skill in the art would be motivated to make such a modification.

Accordingly, claim 1 as well as claims 3-5 which depend therefrom, distinguishes over Simon in view of Hallac and represents allowable subject matter.

Simon and Hallac in view of Stavropoulos

Claims 2, 6, and 28 are rejected pursuant to 35 U.S.C. 103(a) as being obvious over Simon in view of Hallac and in further view of U.S. Patent No. 4,142,517 of Stavropoulos et al. (“Stavropoulos”).

Dependent Claims 2 and 6

The Examiner argues that Simon and Hallac disclose the invention substantially as claimed but fail to disclose various aspects of dependent claims 2 and 6. Thus, the Examiner relies on Stavropoulos

to teach these various aspects. As noted above, claim 1, from which claims 2 and 6 depend, distinguishes over Simon in view of Hallac. With regard to Stavropoulos, even if the Examiner considers the guide tube and beveled edge of Stavropoulos to be an outer tube with a cutting edge, no person having ordinary skill in the art would be motivated to modify the exterior guard tube of Simon with a cutting edge for the same reasons noted above with respect to claim 1. The exterior tube of Simon is specifically configured to prevent the cutting of tissue and such a modification would render the exterior tube unsuitable and unusable for its intended purpose. Accordingly, claims 2 and 6 distinguish over Simon in view of Hallac and in further view of Stavropoulos at least because they depend from an allowable base claim.

Independent Claim 28

Independent claim 28 requires an apparatus for harvesting bone plugs having a tube with an inner bore and a sheath disposed around the tube having a cutting edge at a distal end and a tooth at the distal end extending towards the inner bore for cutting bone. As noted above with respect to claim 1, both Simon and Hallac fail to teach such a configuration. Simon does not teach a sheath or outer tube having a cutting edge and a tooth extending toward an inner bore. To the contrary, the exterior guard tube of Simon is specifically configured to act as a shield that prevents tissue from being accidentally cut by the inner tube. Hallac does not remedy these deficiencies because Hallac simply teaches collapsible biopsy needles. The needles do not have cutting edges or a cutting tooth. Regardless, even if the needles of Hallac or the guide tube and beveled edge of Stavropoulos is considered to be an outer tube with a cutting edge, no person having ordinary skill in the art would be motivated to modify the exterior guard tube of Simon with a cutting edge for the same reasons as noted above with respect to claim 1. In particular, such a modification would render the exterior guard tube of Simon unsuitable and unusable for its intended purpose of guarding against the cutting of tissue. Accordingly, claim 28 distinguishes over Simon in view of Hallac in further view of Stavropoulos and represents allowable subject matter.

Simon and Hallac in view of Torrie

Claim 7 is rejected pursuant to 35 U.S.C. 103(a) as being obvious over Simon in view of Hallac and in further view of U.S. Patent No. 6,358,523 of Torrie et al. (“Torrie”). The Examiner argues that

Simon and Hallac disclose the invention substantially as claimed but fail to teach a bone plug from articular cartilage and underlying bone tissue as required by claim 7. Thus, the Examiner relies on Torrie to teach such a bone plug. Torrie is directed to a method for repairing cartilage and does not teach or suggest a sheath disposed around a tube with an inner bore and having a cutting edge and a tooth for cutting bone extending toward the inner bore, as required by claim 1 from which claim 7 depends. Accordingly, claim 7 distinguishes over Simon in view of Hallac and in further view of Torrie at least because it depends from an allowable base claim.

Conclusion

Applicants submit that all claims are in condition for allowance, and allowance thereof is respectfully requested. Amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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